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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/056,373 | 01/17/2002 | Ernst Bretschneider | DE 010005 | 3917 |

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER

REIS, TRAVIS M

ART UNIT PAPER NUMBER

2859

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/056,373 | Applicant(s) BRETSCHNEIDER ET AL. | |
| | Examiner Travis M Reis | Art Unit 2859 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 1, 2, & 4-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrenk (U.S. Patent 4910707) in view of Berger et al. (U.S. Patent 5225706) & Hayami et al. (U.S. Patent 6426495).

Schrenk discloses an electric circuit arrangement for protecting a chip arrangement comprising a optosensitive detector unit (8) arranged underneath a dielectric opaque epoxy insulation oxide layer with a plurality of pnp photodiodes (col. 4 lines 5-15) (Figure 4), a power supply resistor (15) & a reference resistor (16); whose output voltage is a measure of the intensity of incident light on the detector unit, an evaluation/logic unit/logic gates, connected to the sensor outputs and blocking circuits (10a)(col. 2 lines 11-17); and connected to an erasable EEPROM storage unit (5) further connected to a control logic unit

(7); wherein the data of the chip arrangement to be protected can be permanently blocked, or short circuited (1a) (col. 1 lines 61-68) (col. 2 lines 52-58).

Schrenk does not disclose a comparator unit preceded by the detector unit provided for comparing the output voltage of the detector unit with an adjustable reference voltage or the generation of a failure message occurring during comparison of the output voltage of the detector unit with the reference voltage when the output voltage deviates from the nominal range.

Hayami et al. discloses temperature compensating circuit, temperature compensating logarithm conversion circuit and light receiver with a comparator unit provided for comparing the output voltage of the detector unit with an adjustable reference voltage which then generates a failure message when the output voltage deviates from the nominal range (col. 17 lines 26-35). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the comparator unit disclosed by Hayami et al. to the detector unit disclosed by Schrenk in order to improve the reaction time of the detector unit to protect the data by blocking or short circuit.

Furthermore, with reference to claims 17 & 18, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. implemented and/or integrated in a card) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Schrenk does not disclose a bipolar transistor with emitter connected to the input of the comparator unit and the power supply voltage via the power supply resistor, while a collector is connected to ground via the reference resistor, and a junction of the bipolar

transistor is provided for absorbing light, but does disclose that photoresistors are also suitable sensors (col. 3 line 37)

Berger et al. discloses a matrix of photosensitive elements associating a photodiode or a phototransistor (aka bipolar resistor) (i.e. that a photodiode is replaceable with a phototransistor) and a storage capacitor with an emitter (38), a junction (36) for absorbing light, and collector (34) (Figure 5) (col. 7 lines 7-25), wherein the phototransistor has the advantage of a higher sensitivity (col. 1 lines 28-31). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the photodiode disclosed by Schrenk with the phototransistor, emitter & collector disclosed by Berger et al. and to connect them to the power supply resistor & reference resistor disclosed by Schrenk in order that the device would have the advantage of a higher sensitivity.

Response to Arguments

4. In response to applicant's arguments that Berger is not used in the rejection of independent claims 1 & 25; these arguments have been fully considered but they are not persuasive since Berger is used to show that a bipolar transistor is an obvious feature to add to a optosensitive detector unit, said feature being part of the claim language of claims 1 & 25, as detailed above in paragraph 3.

5. In response to applicant's argument that there is no suggestion to combine the references (i.e. the circuit disclosed by Schrenk & the comparitor unit disclosed by Hayami et al.), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). In this case, the advantage of a comparator unit in an optically based circuit, which would improve reaction time, would provide sufficient motivation to combine Schrenk & Hayami et al, as detailed above in paragraph 3.

6. In response to applicant's arguments that Schrenk fails to teach "data ... can be permanently obstructed ..." as set forth in claim 1; these arguments have been fully considered but they are not persuasive since Schrenk does disclose permanent blocking, as detailed above in paragraph 3. Furthermore, Applicant's citation of col. 2 lines 13-15 of Schrenk makes no disclosure of temporary blocking, nor was there any disclosure of temporary blocking in the entire reference.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis
Examiner
Art Unit 2859

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

tmr
September 17, 2004


G. BRADLEY BENNETT
PRIMARY EXAMINER
AU 2859